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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,390	10/03/2003	Kenneth J. Artis	158079-0003	3517
29000 7590 02/16/2010 IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067				
EXAMINER				
LIU, CHIA-YI				
ART UNIT		PAPER NUMBER		
3695				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/678,390

**Applicant(s)**

ARTIS, KENNETH J.

**Examiner**

CHIA-YI LIU

**Art Unit**

3695

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to a Request for Continued Examination submitted 1/26/2010. Applicant has amended Claim 1 and added new Claims 45 and 46. Claims 1-17 and 45-46 are now pending for examination.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 46 is rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. (See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876))

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17, 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 1-17, it is unclear what the structure elements are. System claims are defined by their structure elements and any corresponding functionality. The "user interface routine", "processing handling routine", "accounting routine", "administrative interface routine" and "benefit redemption routine" do not impart structure. Appropriate correction is required.

As per Claims 1, 45 and 46, it is unclear what the Applicant meant by "a work-specific controlled escrow account." Every escrow account is created to perform some type of work. It is unclear what Applicant regards as his or her invention. One cannot reasonably determine the scope of the claim. Depending claims 2-17 inherit the same USC 112 deficiency as Claim 1 and are rejected in the same manner as above. Appropriate correction is required.

Claims 1, 45 and 46 recite the limitation "providing viewing access for the artist associated with developing the undeveloped creative work of the monetary amount in the escrow account." It is unclear whether the artist associated with developing is allowed to view the undeveloped creative work that is associated with the monetary amount or that the artist is allowed to view the monetary amount in the escrow account. The claims are ambiguous for having more than one possible meanings or interpretations. Depending claims 2-17 inherit the same USC 112 deficiency as Claim 1 and are rejected in the same manner as above. Appropriate correction is required.

Claims 1, 45 and 46 recite the limitation "providing viewing access for the artist associated with developing the undeveloped creative work of the monetary amount in the escrow account." "Providing viewing access" does not necessarily require the "viewing" to be performed. It is unclear what step or apparatus, if any, is required to

provide viewing access. One cannot reasonably determine the scope of the claim. Depending claims 2-17 inherit the same USC 112 deficiency as Claim 1 and are rejected in the same manner as above. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 45 and 46 are rejected under 35 U.S.C. 103(a) as being anticipated by Camelio (US 2004/0015427) in view of Weichert (US 7,003,493 B2), further in view of Pittelli (US 2002/0198763 A1) and further in view of Massey, Jr. (US 6,792,411 B1)

As per Claims 1, 45, 46

Camelio ('427) discloses

providing to remote users presentation information (advertisement for the project) concerning specific undeveloped creative works seeking financial sponsorship, see paragraph 0002 (obtain financing from interested individuals to produce a creative work) and paragraph 0051 (webpage for generating capital for a project of an artist include advertisement for the project)

said undeveloped creative works including motion picture works, see paragraph 0083 (finance and invest in new creative works: film)

receiving and processing requests from remote users for purchases of predefined benefits (purchase rights) relating to a specific undeveloped creative work, see at least paragraph 0002

storing patron information received from the remote user and associating the patron information to the specific undeveloped creative work selected by the remote user, see at least Fig 50 (patron account management: personal info, purchases) and paragraph 0165 (link to a web page to view patron information include name and description of the patron and inventory to which a respective patron have selected through financing the project)

aggregating monetary amounts in an escrow account, see paragraphs 0144 and 0145 (money contributed by patron may be placed in an escrow) Limitations identifying the type of escrow account used (work-specific controlled escrow account) is merely non-functional descriptive material and, non-functional descriptive material cannot render non-obvious an invention that would have been otherwise been obvious (In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983))

Camelio ('427) fail to explicitly disclose wherein said presentation information includes a plot description of at least one of the undeveloped motion picture works. Massey ('411) teaches the information concerning a creative work (movie) to be produced include a plot description, see column 4. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include wherein said presentation information includes a plot description of at least one of the undeveloped motion picture works. One would have been motivated to do so for the benefit of allowing patrons to decide what creative works are worth investing in based on how interesting he or she thinks the plots are.

Camelio ('427) teaches releases (capital turned over to artist) all or a portion of the aggregated monies (see paragraph 0144, lines 5-6) to facilitate completion of the undeveloped creative work (new project), see paragraph 0145, lines 1-3, but fails to explicitly disclose the monetary amount is released when a predefined target threshold amount is attained. Weichert ('493) teaches the monetary amount is released when a predefined target threshold amount is attained (funds can be held in the account until a threshold amount is crossed that would trigger an automated payout), see column 13, lines 43-46. Both Camelio and Weichert are directed toward fund transfer system. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include the monetary amount is released when a predefined target threshold amount is attained. One would be motivated to do so, for the benefit of allowing artists to use fund to start on a project when a predetermined financial goal is reached.

Camelio ('427) teaches patron's information includes email, see paragraph 0165, but fail to explicitly disclose electronically notifying patrons associated with the specific undeveloped creative work concerning availability of their purchased benefits. Official Notice [now admitted prior art] is taken that it was old and well known in the art to electronically notify people news concerning their investments or benefits. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include electronically notifying patrons associated with the specific undeveloped creative work concerning availability of their purchased

benefits. One would have been motivated to do so for the benefit of keeping patrons updated on changes associated with their benefits.

Camelio ('427) teaches patron's information includes email, see paragraph 0165, but fail to explicitly disclose electronically notifying patrons upon the condition that the predefined target threshold amount is not attained. Pittelli ('763) teaches if the artist does not obtain a certain level of predefined support, the consumer is entitled to a refund of their contribution, see paragraph 0035. Since consumer is entitled to a refund if the predefined threshold is not attained, it would have been obvious to notify (email) the patron about the refund he or she is or will be getting. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include electronically notifying patrons upon the condition that the predefined target threshold amount is not attained. One would be motivated to do so for the benefit of keeping patrons updated on what happened to the funds he or she contributed.

Camelio ('427) teaches money contributed by fan may be place in an escrow account, see paragraph 0144, and when the artist has reached has financial goal the project may then be produced, see paragraph 0145, but fails to explicitly disclose providing viewing access for the artist associated with developing the undeveloped creative work of the monetary amount in the escrow account. However, since the artists are allowed to raise capital on their own, see paragraph 0007 of Camelio, it would be obvious to allow the artist to know how much money he/she has raised (money raised= money contributed by fan= monetary amount in escrow account). Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include providing viewing access for the artist associated with developing the undeveloped creative work of the monetary amount in the escrow account. One would be motivated to do so, for the benefit of allowing artists to know if enough funding has been raised to complete his/her work.

Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. "For use in development of the specific undeveloped creative work", "to facilitate completion of the specific undeveloped creative work" are merely an intended use that does not result in a structural difference and therefore does not have patentable weight.

As per Claim 2.

Camelio ('427) further discloses means for disseminating to user-interactive devices (ArtistShare) presentation information relating to one or more undeveloped creative works, see paragraph 0107, lines 3-6 and paragraph 0080, lines 2-3, 11-15.

As per Claim 3.

Camelio ('427) further discloses a web server coupled to a storage medium (database) having stored thereon one or more web pages containing the presentation information (information of creative works), see paragraph 0047, lines 3-6, and paragraph 0052, lines 4-6.

As per Claim 4

Camelio ('427) further discloses software instructions for executing steps whereby the presentation information is downloaded to remote computerized machines (PDA, personal computer) configured to allow a plurality of different potential patrons to review the presentation information, see paragraph 0169, lines 11-12, paragraph 0087, lines 3-4, paragraph 0081, lines 23-27.

As per Claim 5

Camelio ('427) further discloses software instructions for execution on a remote patron computer and data files comprising at least a portion of said presentation information, see paragraph 0087, lines 3-4 and paragraph 0082.

As per Claim 6

Camelio ('427) further discloses presentation information (artist's creations) exists in static medium (CD), wherein said form on a printed or magnetic see paragraph 0085, lines 11-14, and paragraph 0187, lines 24-31.

As per Claim 7

Camelio ('427) further discloses the process handling routine receives electronic payment information from the patron electronically (Internet payment) from user-interactive devices and automatically provides the electronic payment information to said accounting routine for aggregation with other received funds, see paragraph 0087, lines 10-15.

As per Claim 8



Camelio ('427) further discloses a process handling routine collects patron information including the name of the patron and the patron's e-mail address, and associates the patron information with the undeveloped creative work and the purchased benefits, see at least paragraph 0165 , lines 1-2, 5-10 and Fig 51.

As per Claim 9

Camelio ('427) further discloses benefit redemption routine uses the patron's email address to notify the patron concerning the availability of the patron's purchased benefit or that the predefined target threshold amount was not attained, see Claim 1 above.

As per Claim 10

Camelio ('427) further discloses the purchased benefit comprises a copy (downloadable recording of final project) of or discount relating to the creative work, see paragraph 0120, lines 6-8.

As per Claim 11

Camelio ('427) does not specifically disclose a discount relating to merchandise or service relating to the creative work, other than the creative work itself. Pittelli teaches discounts on merchandise associated with the artist (relating to creative work, other than creative work itself) see paragraph 0021, lines 16-19. Both Camelio and Pittelli are directed toward obtaining financing from interested individuals to produce a work. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include a discount relating to merchandise or service relating to the creative work, other than the creative work itself. One would be motivated to do so for the benefit of attracting fans to financially contribute to the development of artists.

As per Claim 12

Camelio ('427) does not specifically disclose a copy of or discount on a creative work different from the undeveloped creative work or to other merchandise or services unrelated to the undeveloped creative work, Pittelli teaches discount to other services (concert), see paragraph 0021, lines 16-19. Both Camelio and Pittelli are directed toward obtaining financing from interested individuals to produce a work. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Camelio's invention to include a copy of or discount on a creative work different from the undeveloped creative work or to other merchandise or services unrelated to the undeveloped creative work. One would be motivated to

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do so for the benefit of attracting people to financially contribute to the undeveloped work.

As per Claim 13

Camelio ('427) further discloses data in the storage medium is updated to include presentation information relating to in-progress development (project status, process) or completion of the creative work (finish date, release date), see figure 8.

As per Claim 14

Camelio ('427) further discloses the updated presentation information comprises audio, image and/or [visual] video data of the creative work, see paragraph 0171 and 0172 and Fig. 32.

As per Claim 15

Camelio ('427) further discloses an update notification routine having access to the patron information, stored in the storage medium, for facilitating automatic electronic notification of patrons associated with a particular undeveloped creative work concerning the updated presentation information, see paragraph 0165, lines 1-2, paragraph 0145 lines 1-4, and paragraph 0160, lines 3-5 and Claim 1 above.

As per Claim 16

Camelio ('427) further discloses the purchased benefit comprises digital data (CD) relating to the creative work, and wherein a patron may obtain the purchased benefit electronically by accessing the computerized system and requesting electronic transmission of the digital data to a patron's computer, paragraph 0146, lines 1-4.

As per Claim 17

Camelio ('427) does not specifically disclose benefit redemption routine electronically transmits a key number to said patrons, which may be used by said patrons to redeem the purchased benefit online and/or at a point-of-sale location.

Official Notice [now admitted prior art] is taken that it is old and well known in the coupon redemption arts to have numbers on coupons for redemption, for example, electronic coupons, for identification of the redemption offer and the associated products. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a number to redeem

benefits online. One would be motivated to do so for the benefit of allowing patrons to more easily and conveniently redeem their benefits.

### ***Response to Arguments***

Applicant's arguments filed 1/26/2010 have been fully considered but they are not persuasive.

In response to applicant's argument that Weichert is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Camelio ('427) teaches releases all or a portion of the aggregated monies, see paragraph 0145, but fails to explicitly disclose the monetary amount is released when a predefined target threshold amount is attained. Weichert ('493) teaches releasing monetary amount when a predefined target threshold amount is attained (funds can be held in the account until a threshold amount is crossed that would trigger an automated payout), see column 13, lines 43-46. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. One would be motivated to do so, for the benefit of allowing artists to use fund to start on a project when a predetermined financial goal is reached.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing financial backing for specific undeveloped creative work and not for particular artist) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHIA-YI LIU  
Examiner  
Art Unit 3695

/Thu Thao Havan/  
Primary Examiner, Art Unit 3695